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Paper No. 12  
ejs

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Chilay Foods, Inc.

Serial No. 75/699,608

**G. Donald Weber, Jr.** for Chilay Foods, Inc.

Mitchell Front, Trademark Examining Attorney, Law Office  
111 (Craig Taylor, Managing Attorney)

Before Seeherman, Hairston and Drost, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Chilay Foods, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register ULTIMATE SALSA, with the word SALSA disclaimed, for "food products, namely guacamole dip" in Class 29 and "hot sauce namely salsa and taco sauce" in Class 30.<sup>1</sup> Registration has been refused on two grounds: 1) that the mark is merely

<sup>1</sup> Application Serial No. 75/699,608, filed May 4, 1999, and asserting a bona fide intention to use the mark in commerce.

descriptive of the identified goods, Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 2(e)(1); and 2) that applicant's mark, if used on its identified goods, so resembles the mark shown below, and registered for "salsa," as to be likely to cause confusion or mistake or to deceive.<sup>2</sup>



The registration includes the following statements:

The English translation of the foreign wording in the mark, "LA ULTIMA" is "THE ULTIMATE"; and

No claim is made to the exclusive right to use "LA ULTIMA" or "SALSA."

The appeal has been fully brief, but an oral hearing was not requested.<sup>3</sup>

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<sup>2</sup> Registration No. 2,328,282, issued March 14, 2000.

<sup>3</sup> In his appeal brief the Examining Attorney objected to our consideration of third-party registrations which were referenced in applicant's brief because copies of the registrations were not submitted. With its reply brief applicant has attempted to remedy the objection, stating in the brief that it was submitting actual copies of the registrations, although, in point of fact, only a copy of Registration No. 1,671,295 was attached to the brief. In any event, we have considered the four third-party

We turn first to the refusal based on the ground of mere descriptiveness. A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Act, if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services with which it is used. **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed Cir. 1987).

With respect to the goods in Class 30, obviously the word SALSA in applicant's mark is the generic term for one of the goods, salsa. Applicant does not seriously dispute this, and has disclaimed exclusive rights to the word.<sup>4</sup> We also find that the word ULTIMATE is a laudatory descriptive term. The Examining Attorney has quoted the following definitions of "ultimate": "representing or exhibiting the

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registrations. Applicant first referenced these registrations in its response to the first Office action, and the Examining Attorney did not, at any time in the examination of the application, advise applicant that the registrations would not be considered because a mere listing of registrations is not sufficient to make them of record. Accordingly, we deem the Examining Attorney to have waived any objection to the form of the submission.

We also note that, with its reply brief, applicant has submitted exhibits which it alleges to be labels for its goods. This evidence is manifestly untimely, and has not been considered. See Trademark Rule 2.142(d).

<sup>4</sup> In its appeal brief applicant does make the point that "salsa" is also defined as "a kind of Latin American dance music of Afro-Cuban and Puerto Rican origin influenced by jazz and rock." p. 8. In its reply brief applicant appears to retreat from any suggestion that this is the meaning consumers would understand when seeing ULTIMATE SALSA in connection with its identified goods. "Applicant is not urging that Applicant's goods and/or services relate to a musical term." p. 7.

greatest possible development or sophistication" and "utmost; extreme."<sup>5</sup> The Examining Attorney has also made of record a large number of third-party registrations in which the word ULTIMATE has been disclaimed. These registered marks include THE ULTIMATE CHEESECAKE and design, with THE ULTIMATE CHEESECAKE disclaimed, for, inter alia, cakes;<sup>6</sup> THE ULTIMATE CAFÉ and design, with THE ULTIMATE CAFÉ disclaimed, for, inter alia, espresso coffee and coffee beans;<sup>7</sup> and SER THE ULTIMATE CHOCOLATE CAKE and design, with THE ULTIMATE CHOCOLATE CAKE disclaimed, for cakes mixes.<sup>8</sup>

Applicant contends that these third-party registrations contradict the Examining Attorney's position that the word ULTIMATE is descriptive because "each of these examples represents a Registration—not a refusal of registration." Brief, p. 9 (emphasis in original). However, although the various marks have been registered, the fact that the word ULTIMATE has been disclaimed in the registration indicates that this word in each mark has been considered to be merely descriptive.

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<sup>5</sup> The American Heritage Dictionary of the English Language, 3d ed. © 1992.

<sup>6</sup> Registration No. 2,098,784.

<sup>7</sup> Registration No. 1,925,661.

<sup>8</sup> Registration No. 1,689,193.

When these descriptive words ULTIMATE and SALSA are joined in the mark ULTIMATE SALSA, we find that the mark as a whole is merely descriptive of applicant's goods, in that it immediately conveys to consumers that applicant's salsa is the best. This situation presented here is very similar to that discussed in **In re Nett Designs Inc.**, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). In that case, the Court of Appeals for the Federal Circuit, our principal reviewing court, held that THE ULTIMATE BIKE RACK is a laudatory descriptive phrase for a bike rack.

We note that there are four registrations, all owned by the same entity, for the marks ULTIMATE, THE ULTIMATE JUICE and THE ULTIMATE TASTE<sup>9</sup>, for fruit juices, which were not registered on the basis of acquired distinctiveness and/or for which a disclaimer of ULTIMATE was not required. We do not know the circumstances under which these registrations issued but, as the Court noted in **In re Nett Designs**, supra, the Board must assess each mark on the record submitted with the particular application. The fact that another entity was able to obtain registrations for ULTIMATE for fruit juices without disclaimer or resort to the provisions of Section 2(f) does not outweigh the

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<sup>9</sup> This registration was cancelled in 2001 for failure to file a Section 8 affidavit of use.

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evidence of descriptiveness of ULTIMATE as shown by the dictionary definitions and numerous third-party registrations submitted by the Examining Attorney in which ULITMATE was disclaimed.

Accordingly, we affirm the refusal of registration with respect to the application in Class 30 on the ground that ULTIMATE SALSA is merely descriptive of applicant's identified salsa.

Because the application is in two classes, we must also consider whether the mark is merely descriptive of the goods in Class 29, which are identified as "guacamole dip." Although applicant states that SALSA is not descriptive of guacamole, we note that applicant agreed to a disclaimer of SALSA for both classes in the application, thereby indicating that the term is, in fact, descriptive of guacamole dip as well as salsa, i.e., that salsa is an ingredient in the dip. As noted previously, a mark is merely descriptive if it describes an ingredient of the goods. See **In re Engineering Systems Corp.**, 2 USPQ2d 1075 (TTAB 1986). In view of the evidence previously discussed, we find that consumers, upon seeing the mark ULTIMATE SALSA in connection with guacamole dip, will immediately understand that the guacamole dip contains the best salsa. Accordingly, we affirm the refusal of registration based on

Section 2(e)(1) with respect to the Class 30 application as well.

This brings us to the refusal based on Section 2(d) of the Trademark Act. Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With respect to the marks, we note that although the Examining Attorney refers to the cited mark as LA ULTIMA SALSA, the words LA ULTIMA are clearly separated from the word SALSA, and this separation is recognized by the form of the disclaimer of the words, which is not for the phrase LA ULTIMA SALSA, but for LA ULTIMA and SALSA separately.

The Examining Attorney points out that the words LA ULTIMA in the cited mark translate as THE ULTIMATE, such that the meaning of the words of the marks are in effect identical. However, we also note that the words LA ULTIMA SALSA are descriptive (LA ULTIMA) and generic (SALSA) for the goods, and that applicant has disclaimed rights to the

exclusive use of these words. Thus, we find it difficult to base a finding of likelihood of confusion on the mere fact that applicant's mark contains the English version of words to which registrant has no exclusive rights.

Moreover, we do not agree with the Examining Attorney that the design in the center of the registered mark, which appears to be an abstract depiction of chili peppers, is subordinate to the word portion, and deserves less weight in the comparison of the marks as a whole. Rather, the picture occupies a prominent position in the mark, both because of its placement in the center of the mark, separating the words, and because of its size.

Further, because of the placement of the design, the cited mark appears to be the words LA ULTIMA, with the word SALSA as a subordinate part of the mark, indicating the name of the product, SALSA.

Accordingly, the marks are different in appearance, pronunciation and commercial impression. Although when the words are translated they have the same meaning, because of the manner in which the registered mark is displayed, there is even some degree of difference in connotation of the marks as a whole, with the cited mark, as noted above, emphasizing LA ULTIMA, while the applied-for mark is the phrase ULTIMATE SALSA.

Accordingly, and because the cited mark is entitled to a very limited scope of protection, we find that applicant's mark is not likely to cause confusion with the cited registration even if they are used on identical goods, salsa. If applicant's mark is used on guacamole dip, the goods of its Class 29 application, this adds an additional degree of difference.

Decision: The refusal of registration pursuant to Section 2(e)(1) on the ground that applicant's mark is merely descriptive of its goods in both classes is affirmed; the refusal of registration pursuant to Section 2(d) on the ground of likelihood of confusion is reversed as to both classes.<sup>10</sup>

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<sup>10</sup> We note that in its appeal brief applicant states that it has not declined the Examining Attorney's suggestion (made during the course of examination) that it may want to consider amending the application to the Supplemental Register "but, rather, is merely holding such action in abeyance until the present discussions are considered by the TTAB." Brief, p. 10. Applicant is reminded that Trademark Rule 2.142(g) provides, in relevant part, that an application which is decided on appeal, as has this one, will not be reopened except upon order of the Commissioner, and a petition to the Commissioner to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.